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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,644	03/06/2002	Tiecheng A. Qiao	83598D-W	9144

7590 04/14/2004

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EXAMINER

NUTTER, NATHAN M

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary	Application No. 10/091,644	Applicant(s) QIAO ET AL.	
	Examiner Nathan M. Nutter	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 25-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group II, specifically claims 2 and 3/2, 4-6, 7/2, 8-13, 14/2, 15-18, 19/2-22/2, 23 and 24/2, in the Paper filed 18 March 2004 is acknowledged. The traversal is on the ground(s) that:

1) "the inventions of Groups I and II are both a gelatin-based substrate including a substrate having gelatin on at least one surface and a polymer scaffold affixed to the gelatin surface, and wherein both groups require one or more reactive units capable of interacting with a protein or a protein capture agent. There is significant overlap in the fields of search...(which) are identical for Groups I and II."

2) "the inventions of Groups III and IV are both a method (sic) of making a gelatin-based substrate including providing a support, (by) coating on the support a composition...affixing a polymer scaffold to a surface of the (coating), wherein both polymer scaffolds (sic) have or interact with one or more reactive units capable of interacting with a protein or a protein capture agent. There is significant overlap in the features, and therefore in the fields of search...(which) are identical for Groups III and IV."

3) "The process of claim 25 requires each and every element of the product of claim 1, and therefore necessarily results in at least the product of claim 1. Because the product of claim 1 (Group I) is included within the process of claim 25 (Group III), there is significant overlap in the search field that would place no undue burden on the Examiner."

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4) "The process of claim 26 (Group IV) reads as steps for putting together the exact features of claim 2 (Group II). The process of claim 26 requires each and every element of the product of claim 2, and therefore necessarily results in at least the product of claim 2. Because the product of claim 2 (Group 11) is included within the process of claim 26 (Group IV), there is significant overlap in the search field that would place no undue burden on the Examiner."

5) "The Examiner asserts at page 4 the inventions of all Groups I-IV "are distinct . . . and have acquired a separate status in the art as shown by their different classification". However, as shown by the excerpt below from page 1 of the Office Action, all of Groups I-IV share the same fields of search".

This is not found persuasive because the searches for Groups I and II overlap directly, as do the searches for Groups III and IV. However, the searches for the article claims and the searches for the process claims differ significantly, as shown in the restriction requirement. The concepts between Group I and Group II and between Group III and Group IV differ, as well. The Group I claims do not require the tri-functional compound required in the Group II invention. The additional component is deemed to affect the characteristics of the final product, patentably. Further, differences between Group I and Group II and between Group III and Group IV include the fact that the polymer scaffold, as recited by Group I, binds to the protein, and the tri-functional ligand of the Group II claims is employed in the protein binding capacity. Clearly different concepts. As regards the claims traversed in parts 3) and 4), above, it is noted that the claims of the Group III and Group IV inventions are drawn to methods of

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making. Each method recites steps. Other constituents could be employed in those steps. The claims are not product-by-process claims. Furthermore, claims 25 and 26 claim a support along with a polymer scaffold, as recited in the Group I and Group II claims. As such, the processes of Groups III and IV do not appear to produce the articles recited in Groups I and II, respectively, as asserted by counsel. An undue burden would clearly be placed upon the Examiner to examine all of the claims. The inventions are properly restrictable, as pointed out in the original restriction, and supplemented herein. Further, regardless of how counsel characterizes "an undue burden", most inventions are classified into one class, with one or two subclasses. Search time is limited for patent applications in the name of fairness, and not to be unduly burdensome to the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

Counsel asserts in her Response of 18 March 2004 that "the Examiner did not acknowledge consideration of the P. I. Rose reference submitted in the Information Disclosure Statement and Form PTO-1449 filed June 11, 2002, because the Examiner was unable to determine the date of the reference." The Examiner did not acknowledge consideration of the P.I.Rose document because it was improperly cited. A date must be included in the citation by the applicant. See M.P.E.P. 609 and 37 C.F.R. 1.98(b)(5). Applicants should be more diligent to fill out PTO forms in accordance with the statutes drawn thereto.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2, 3/2, 4-6, 7/2, 8-13, 14/2, 15-18, 19/2-22/2, 23 and 24/2 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/020,747. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application recites the broad term "support" and in the instant application the claims recite a "polymer scaffold", which is essentially the support of the composition. The employment of the polymer support over others, known in the art, such as a glass or ceramic support, would have been prima facie obvious to one in view of the claims of 10/020,747.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

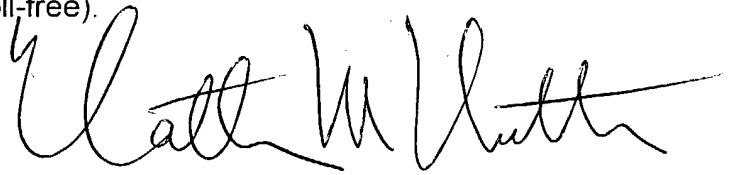
The reference to Gaddy et al, cited of interest, teaches the manufacture of a substrate coated with gelatin and reacted with compounds that are embraced herein to read on the tri-functional compound employed and claimed. Gaddy et al employ a ceramic base and use polyfunctional agents, including glutaraldehyde and diisocyanates, that ultimately are employed in reaction with the proteinaceous coat of yeast. Note column 3 (lines 4-44) and claim 10, in particular. The reference is not deemed to present a bar to the patentability of the instant claims, and a copy will NOT be furnished with this Office Action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on Monday-Friday 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Nathan M. Nutter", with a long horizontal flourish extending to the right.

Nathan M. Nutter
Primary Examiner
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nmn

11 April 2004